

Remarks

This Amendment is in response to the Office Action dated November 17, 2003 wherein claims 34-50 were rejected under 35 U.S.C. §103(a) as being obvious over US 6348065 to Brown et al (Brown) in view of U.S. 5,449,373 to Pinchasik et al.

In addition to the rejection the Examiner requested a new copy of the Amendment After Final, which was filed on July 1, 2003, as the facsimile copy that he received was of poor quality. A copy of the previous amendment is included herewith.

Claims 46 and 47 have been amended above to correct a typographical error.

Claim Rejections – 35 U.S.C. §103

In the Office Action claims 34-50 were rejected under §103(a) as being obvious over Brown in view of Pinchasik. More specifically, the Examiner asserted that it would be obvious to make the interconnectors of Brown curved for the same reasons that Pinchasik does the same in order to better support the area between the segments. The Office Action noted that FIGs. 2A-2C of Pinchasik show connectors that are longitudinally and circumferentially offset.

Pinchasik's Discussion of Connectors of Figs. 2A-2C

When the connectors 110 of FIGs. 2A-2C of Pinchasik are viewed in light of the entire Pinchasik reference, one of ordinary skill would not be motivated to combine the connectors 110 with the stent of Brown. Such connectors are indicated by Pinchasik to be less desirable than the kinked connectors (whose ends are aligned along a longitudinal axis of the stent) shown in Figs. 3A-3C of Pinchasik because connectors 110 are said to have a tendency to bias inward and rupture balloon 118 when the stent is flexed (column 4, lines 38-43). Thus, not only does Pinchasik not suggest using the connectors of Figs. 2A-2C in the Brown stent but Pinchasik effectively teaches away from their use.

The Office Action Fails to Establish a Motivation to Combine in the Prior Art

In re Fine 5 USPQ2d 1596 (Fed. Cir.1988), referenced in the Office Action, states, in reference to the PTO's burden of establishing a *prima facie* case of obviousness, "It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge

generally available to one of ordinary skill in the art *would lead that individual to combine the relevant teachings of the references.*" (emphasis added).

The Examiner posits "that it would have been obvious to make the interconnectors of Brown curved for the same reasons that Pinchasik does the same and in order to better support the area between the segments."

The former assertion does not identify what constitutes Pinchasik's motivation and, as such, is merely conclusory. Conclusory statements by themselves are insufficient evidence to establish a motivation to combine (see, for example, *In re Dembiczak*, 50 USPQ2d at 1617).

Applicant further notes that Pinchasik's connectors are for flexibly connecting rigid segments together. Brown, on the other hand, attempts to improve flexibility within the segments rather than via the connectors. Thus, one of ordinary skill in the art would not have the motivation to substitute the connectors of Pinchasik into the Brown stent.

As to the latter assertion, the Office Action does not show any prior art teaching in the general knowledge or in Pinchasik that curved connectors provide better support. Pinchasik states (col. 2, lines 27-33):

The connectors can be implemented as a plurality of substantially helical links connecting adjacent segments. Alternatively, the connectors can be implemented as links each having at least one kink. The connectors typically have between 8-24 links to provide continuous and uniform support for both straight and curved portions of a bodily conduit.

Thus, the "better support" provided by the connectors appears to be a result of uniformly distributing a sufficient number of connectors between segments and not a result of providing curved connectors *per se*.

Quite simply, the Office Action has not established a *prima facie* case of obviousness.

The Office Action further states:

...the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art...In this case, the knowledge of curved connectors is generally available in the art to one of ordinary skill since Pinchasik provides this knowledge.

The Office Action appears to be implying that knowledge in the art of curved connectors (whose ends are unaligned on a longitudinal axis) is sufficient to provide motivation for a combination. *In re Fine*, however, discussed above, requires that the prior art also provide a suggestion to combine the known features. The Office Action does not point to any suggestion. Thus, even if curved connectors (whose ends are unaligned on a longitudinal axis) were known in the prior art, the Office Action has failed to provide evidence of a suggestion to make the proposed combination.

CONCLUSION

In view of the foregoing it is believed that the present application, with claims 34-50 is in condition for allowance. Early action to that effect is earnestly solicited.

Respectfully submitted,

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